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10/623,134	07/18/2003	Richard L. Sandor	7634-4000	4476
28765 7590 11/05/2009 WINSTON & STRAWN LLP PATENT DEPARTMENT 1700 K STREET, N.W. WASHINGTON, DC 20006				
EXAMINER				
VETTER, DANIEL				
ART UNIT		PAPER NUMBER		
3628				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/623,134

Applicant(s)

SANDOR, RICHARD L.

Examiner

DANIEL VETTER

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 50-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 50-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Claims

1. Claims 1-12, 21, 23, 24, and 37-49 were previously pending. Claim 1 was amended, claims 2-12, 21, 23, 24, and 37-49 were canceled, and new claims 50-69 were added in the reply filed June 30, 2009. Claims 1 and 50-69 are currently pending.

Response to Arguments

2. Applicant's arguments with respect to the rejections under § 103(a) have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 55-69 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

5. Claims 55-69 are directed to a series of steps. In order for a series of steps to be considered a proper process under § 101, a claimed process should either: (1) be tied to a particular machine/apparatus or (2) transform an underlying article or materials. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). Thus, to qualify as patent eligible, these processes must positively recite the other statutory class to which it is tied (e.g., by identifying the apparatus that accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g., by identifying the product or material that is changed to a different state). Although the preamble indicates a physical computing environment in which the steps are intended to be performed, this alone does not serve to place any meaningful limits on what machine actually performs the steps listed in the body. Moreover, no underlying physical subject matter is manipulated or transformed by the recited steps, only abstract

data elements. As such, the claims concretely identify neither the apparatus performing the recited steps nor any transformation of underlying materials, and accordingly are directed to non-statutory subject matter. *See also In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008) (en banc) (clarifying the "machine-or-transformation" test). Examiner recommends amending the claim to positively recite the limitation "performing by a computer system . . ." in the body of the claim rather than the preamble.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1 and 50-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 1 recites "a participant's account is credited or debited by adding . . . or subtracting emission allowances" and that "a trading platform communicatively used by participants to exchange . . ." These limitations seem to require that an actions or steps must be performed to meet the requirements of the claim, however these claims are not directed to a process. A single claim that claims both an apparatus and the method steps of using the apparatus is indefinite. *IPXL Holdings v. Amazon.com, Inc.*, 430 F.2d 1377, 1384, 77 USPQ2d 1140, 1145 (Fed. Cir. 2005). These claims do not properly apprise the public as to what would constitute infringement (i.e., creation of the claimed system or the act of using it) and accordingly are rejected as vague and indefinite under § 112, second paragraph. Dependent claims 50-54 inherit the deficiencies of base claim 1 and, as such, are rejected for the same reasons.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 55-58, 60-66, 68, and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sandor, *Corporate Giants to Aid in Design of US Carbon Market*, ENVIRONMENTAL FINANCE, June 2001 (Reference C2 of the IDS submitted Jan. 5, 2006) in view of EPA's Clean Air Market Programs: Programs and Regulations, *Acid Rain Program: Overview*, July 15, 2001 ("Acid Rain Program") (Reference U of the attached PTO-892).

10. As per claim 55, Sandor teaches a computer-implemented method for reducing total greenhouse gas emissions from participants who conduct or direct activities that generate greenhouse gas emissions, the method comprising performing by a computer-system a plurality of steps including:

crediting to participants that generate greenhouse gas emissions (an emitting participant) certain emission allowances representing a portion of a target amount of greenhouse gas emissions for a specified time period determined as a baseline amount decreased by a reduction schedule, crediting and debiting emitting participants by adding to and subtracting from, respectively, an amount of emission allowances held by the emitting participants in an electronic account in a registry database (Table 3—Central registry; col. 3);

receiving periodically activities information concerning actual greenhouse gas emissions by the emitting participants during the time period (Table 3—Emissions/project monitoring);

exchanging for economic value emission allowances so that, subsequent to the exchange, no emitting participant has less emission allowances than that corresponding to the amounts of actual greenhouse gas emissions generated by the activities conducted or directed by that participant (Table 3—Tradable Instruments; col. 3).

Sandor suggests through its intent to minimize emissions that at some point the allowances will be debited from the participants (see cols. 2-3; Table 3—Central

registry/emissions database). However, it does not explicitly disclose the step of debiting from emitting participants allowances representing the actual amounts of greenhouse gas emitting generated by the activities conducted or directed by that participant; which is taught by Acid Rain Program (pgs. 4,5—Allowance Trading, Annual Reconciliation; pg. 7—Excess Emissions). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate this element in order to reduce emissions (as taught by Acid Rain Program, pg. 9). Moreover, this is merely a combination of old elements in the art or emission allowances. In the combination, no element would have served a purpose other than it already did independently, and one skilled in the art would have recognized that the combination could be implemented through routine engineering producing predictable results.

Examiner notes that the limitation "so that each emitting participant's account holds a number of emission allowances representing a quantity of emissions that is at least equal to the amount of actual greenhouse gas emissions generated or directed by that participant for the specified time period" is construed as an expression of the intended result of the "exchanging" step. This limitation is only afforded patentable weight to the extent that it imparts requirements beyond the positively recited "exchanging" step. See MPEP § 2111.04. This requirement is met by the cited art Sandor and Acid Rain Program, as the exchanging disclosed in the references are fully capable of achieving this result (see Sandor, col. 3; Acid Rain Program, pgs. 3-4).

11. As per claim 56, Sandor in view of Acid Rain Program teaches claim 55 as above. Sandor further teaches crediting to participants that mitigate greenhouse gas emissions (a mitigating participant) emission allowances representing the amounts of greenhouse gas mitigated by the activities directed by that participant (Table 3—Eligible offsets projects; col. 3).

12. As per claim 57, Sandor in view of Acid Rain Program teaches claim 55 as above. Sandor further teaches the activities directed by the emitting participants are operated with the objective that their total emission not exceed the target amount (col. 3).

13. As per claim 58, Sandor in view of Acid Rain Program teaches claim 55 as above. Sandor further teaches emission allowances comprise exchange allowances (XA) representing allowed emissions and exchange offsets (XO) representing mitigations, the XAs and XOs standing for standard quantities of greenhouse gas emissions (Table 3—Tradeable instruments; col. 3).

14. As per claim 60, Sandor in view of Acid Rain Program teaches claim 55 as above. Sandor further teaches a reduction schedule comprises a fractional reduction of the baseline with the reduction fractions being substantially the same for all emitting participants having certain common characteristics (col. 3).

15. As per claim 61, Sandor in view of Acid Rain Program teaches claim 55 as above. Sandor further teaches exchanging further comprises crediting a participant's electronic account with allowances received during the exchange and debiting a participant's electronic account for allowances provided during the exchange (Table 3—Central registry; col. 3).

16. As per claim 62, Sandor in view of Acid Rain Program teaches claim 55 as above. Sandor further teaches received emission and mitigation information for the activities conducted or directed by each participant is stored in an emissions database in a manner that is associated with that participant (Table 3—Central registry; col. 3).

17. As per claim 63, Sandor in view of Acid Rain Program teaches claim 55 as above. Acid Rain Program further teaches providing limits to the recognition, use, sale or banking of allowances credited for the specified time period, including a limit on the recognition, use, sale or banking of allowances remaining after debiting the allowances representing actual emissions (pg. 3—Allowance Trading). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate this element for the same reasons as claim 55 above.

18. As per claim 64, Sandor in view of Acid Rain Program teaches claim 55 as above. Sandor further teaches determining a quantity of actual emissions and mitigated emissions from an activity conducted or directed by a participant by applying rules to operating information regarding the activity, wherein the activity can be classified as a

standard type of activity and the rules applied are pre-determined and standard for that type of activity (Table 3—Eligible offset projects, Industries and firms targeted; col. 3).

19. As per claims 65 and 66, Sandor in view of Acid Rain Program teaches claims 55 and 58 as above. Sandor further teaches buying or selling emission allowances between the participants or conducting one or more auctions of emission allowances, the auction comprising single clearing price auctions and discriminating price auctions (Table 3—Trading mechanisms, Annual public auctions; col. 3).

20. As per claim 68, Sandor in view of Acid Rain Program teaches claim 56 as above. Sandor further teaches the mitigating activities further comprise reducing greenhouse gas emissions through one or more of no-till farming, planting and maintaining trees or other vegetation, capturing and destroying or storing methane and other greenhouse gases, recycling, switching to renewable fuels, generating electricity without burning fossil fuels (solar, wind, hydroelectric and biomass systems), and by using energy more efficiently (Table 3—Eligible offset projects).

21. As per claim 69, Sandor in view of Acid Rain Program teaches claim 55 as above. Sandor further teaches the generating activities further comprise one or more of transportation, commercial, residential, industrial, or energy-generation activities (Table 3—Industries and firms targeted).

22. Claims 1 and 51-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sandor in view of Acid Rain Program and Soestbergen, et al., U.S. Pat. Pub. No. 2002/0143693 (Reference of the IDS submitted Jan. 5, 2006).

23. As per claim 1, Sandor teaches a computer-implemented emissions reduction trading system comprising:

a registry database that stores electronic accounts for participants that record emission allowances including exchange allowances (XA) and exchange offsets (XO) held by participants in a greenhouse gas emissions market, wherein each XA and XO representing standard amounts of greenhouse gas emissions, wherein a participant's account is credited or debited by adding emission allowances or subtracting emission

allowances from, respectively, that participant's account (Table 3—Central Registry; col. 3),

 a trading platform communicatively used by participants to exchange XAs and XOs (Table 3—Trading mechanism CCX Electronic Market),

 and a computer system communicatively coupled to the registry database and the trading platform, and comprising computer instructions for performing actions including:

 crediting to participants that generate greenhouse gas emissions (an emitting participant) a quantity of XAs representing a portion of a target amount of greenhouse gas emissions for a specified time period, determined as a baseline amount decreased by a reduction schedule (col. 3);

 exchanging for economic value emission allowances so that each emitting participant's account holds a number of emission allowances representing a quantity of emissions that is at least equal to the amount of actual greenhouse gas emissions generated or directed by that participant for the specified time period (Table 3—Tradable Instruments; col. 3); and

 receiving periodically information concerning the quantities of actual greenhouse gas emissions emitted or mitigated during a specified time period, with the quantity of emission allowances in an emitting participant's account being credited with a number of allowances representing the amount of greenhouse gas emissions mitigated by the activities directed by that participant (Table 3—Emissions/project monitoring; cols. 2-3).

Sandor suggests through its intent to minimize emissions that at some point the allowances will be debited from the participants (see cols. 2-3; Table 3—Central registry/emissions database). However, it does not explicitly disclose the quantity of emission allowances being debited by an amount of allowances representing the amount of greenhouse gas emissions generated or conducted by the activities of that participant; which is taught by Acid Rain Program (pgs. 4,5—Allowance Trading, Annual Reconciliation; pg. 7—Excess Emissions). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate this element in order to reduce emissions (as taught by Acid Rain Program, pg. 9). Moreover, this is

merely a combination of old elements in the art or emission allowances. In the combination, no element would have served a purpose other than it already did independently, and one skilled in the art would have recognized that the combination could be implemented through routine engineering producing predictable results.

Examiner notes that the limitation "so that each emitting participant's account holds a number of emission allowances representing a quantity of emissions that is at least equal to the amount of actual greenhouse gas emissions generated or directed by that participant for the specified time period" is construed as an expression of the intended result of the "exchanging" functionality. This limitation is only afforded patentable weight to the extent that it imparts a structural requirement on the invention. See MPEP § 2111.04. This requirement is met by the cited art Sandor and Acid Rain Program, as the exchanging disclosed in the references are fully capable of achieving this result (see Sandor, col. 3; Acid Rain Program, pgs. 3-4).

To the extent that Sandor's disclosure does not explicitly describe the hardware and software elements that make up the claimed system; the use of such elements is old and well-known in the art of emissions credit creating and trading (Soestbergen; ¶¶ 0113-15, 0125-26). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate such elements for the same reasons they are useful in improving the system in Soestbergen (see ¶¶ 0120-21). Moreover, one skilled in the art would have recognized that the using such computing elements to perform the basic functions outlined in Sandor and Acid Rain Program could be implemented through routine engineering producing predictable results.

24. As per claim 51, Sandor in view of Acid Rain Program and Soestbergen teaches claim 1 as above. Sandor further teaches an emission database storing amounts information concerning the quantities of greenhouse gas emitted and mitigated (Table 3—emissions database) and the exchanging further comprises buying or selling emission allowances between the participants or conducting one or more auctions of XAs and XOs, the auction comprising single clearing price auctions and discriminating price auctions (Table 3—Trading mechanisms; col. 3).

25. As per claim 52, Sandor in view of Acid Rain Program and Soestbergen teaches claim 1 as above. Acid Rain Program further teaches the computer system provides limits to the recognition, use, sale or banking of allowances credited for the specified time period, including a limit on the recognition, use, sale or banking of allowances remaining after debiting the allowances representing actual emissions (pg. 3—Allowance Trading). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate this element for the same reasons as claim 1 above.

26. As per claim 53, Sandor in view of Acid Rain Program and Soestbergen teaches claim 1 as above. Sandor further teaches the registry database and baselines and reduction schedules (Table 3—Central registry; col. 3). While the reference does not explicitly teach the particular arrangement (i.e., that baselines and reduction schedules are stored in the Central registry database), it would have been prima facie obvious to one having ordinary skill in the art to arrive at this configuration because it is merely an arrangement of data. The central database described in Sandor Table 3 is capable of storing the desired database. One skilled in the art would have recognized that the data could be stored in any desired database, and further that it could be stored in the particular registry database by known methods and with no unpredictable results.

27. As per claim 54, Sandor in view of Acid Rain Program and Soestbergen teaches claim 1 as above. Soestbergen further teaches the registry database comprises a computer database and computer software instructions, and wherein the trading platform comprises computer user interfaces, computer hardware and computer software instructions (¶¶ 0114-15, 0121). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate these elements for the same reasons as claim 1 above.

28. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sandor in view of Acid Rain Program and Soestbergen, et al. as applied to claim 1 above, further in view of Bartels, et al., U.S. Pat. No. 7,529,705 (Reference A of the attached PTO-892).

29. As per claim 50, Sandor in view of Acid Rain Program and Soestbergen teaches claim 1 as above. Sandor in view of Soestbergen does not teach emission allowances further include early action credits representing recognized or accepted reductions of greenhouse gas emissions achieved prior to the period covered by the reduction schedule; which is taught by Bartels (col. 27, lines 3-8). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate early action credits because this is merely a combination of old elements in emission allowance trading. In the combination, no element would have served a purpose other than it already did independently, and one skilled in the art would have recognized that the combination could be implemented through routine engineering producing predictable results.

30. Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sandor in view of Acid Rain Program as applied to claim 58 above, further in view of Bartels, et al.

31. As per claim 59, Sandor in view of Acid Rain Program teaches claim 58 as above. Sandor does not teach emission allowances include early action credits representing recognized or accepted reductions of greenhouse gas emissions achieved prior to the period covered by the reduction schedule; which is taught by Bartels (col. 27, lines 3-8). It would have been prima facie obvious to one of ordinary skill in the art to incorporate this element for the same reasons as claim 50 above.

32. Claim 67 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sandor in view of Acid Rain Program as applied to claim 55 above, further in view of Sharp, et al., U.S. Pat. Pub. No. 2002/0111892 (Reference A of the PTO-892 part of paper no. 20070611).

33. As per claim 67, Sandor in view of Acid Rain Program teaches claim 55 as above. Sandor in view of Acid Rain Program does not explicitly teach the exchanging comprises buying or selling transactions where at least one third party agrees to perform the transaction in place of any participant to that transaction that fails to

perform; which is taught by Sharp (¶¶ 0141). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Sharp to facilitate an automated payment mechanism in an auction-based marketplace in case the buyer cannot or will not pay (as taught by Sharp; ¶¶ 0141-42). Moreover, this is merely a combination of old and already known elements in the art of auction-based transacting. The combined elements serve no additional function than they already did individually, and one skilled in the art would have recognized that the combination could be implemented through routine engineering producing predictable results.

Conclusion

34. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sowinski, U.S. Pat. No. 6,601,033 (Reference B of the attached PTO-892) teaches a method and apparatus for effectuating commerce in claimant-driven individual pollution credits which allows gas utility consumers to claim pollution credit when reducing their pollution levels while employing energy efficiency measures, which has value. Such reduced pollution credit is given value by a third-party, thus, individuals, government agencies and related parties, working in concert with a third-party identify the need, establish ownership, calculate the pollution credit value, and create a new market that has economic value and environmental benefit.

35. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

36. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL VETTER whose telephone number is (571)270-1366. The examiner can normally be reached on Monday - Thursday 8:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on (571)272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DPV/

/JOHN W HAYES/
Supervisory Patent Examiner, Art Unit 3628